

REMARKS

Cancellation of Claims 18-23, 25-33, 35-48, 58-59 and 66-72 and Withdrawal of Claims 34, 46, 49-57 and 60-65 in Response to Restriction Requirement

In the February 12, 2002 Office Action, the Examiner imposed a twelve way restriction requirement against claims 1-72 and required election of one of the following groups:

Group 1 (claims 1-17 and 24) drawn to a chimeric polypeptide wherein the polypeptide is selected from Retroviridae (HIV, SIV, FIV, FeLV), classified in class 424, subclass 207.1;

Group 2 (claims 1-5, 10-17 and 24) drawn to a chimeric polypeptide wherein the polypeptide is selected from Parvoviridae (FPV = feline panleukemia virus), classified in class 424, subclass 233.1;

Group 3 (claims 1-5, 10-17 and 24) drawn to a chimeric polypeptide wherein the polypeptide is selected from Herpesviridae, classified in class 424, subclass 229.1;

Group 4 (claims 18-23) drawn to a chimeric polypeptide which contains a third heterologous domain, classified in class 424, subclass 193.1;

Group 5 (claims 25-28) drawn to a polynucleotide encoding a chimeric polypeptide, classified in class 536, subclass 23.4;

Group 6 (claims 29-33) drawn to an antibody to the chimeric polypeptide, classified in class 530, subclass 388.3;

Group 7 (claims 34-43 and 45) drawn to a method of administering an effective amount of a chimeric polypeptide to achieve antibody production, classified in class 800, subclass 3;

Group 8 (claims 34-43 and 45) drawn to a method of administering an effective amount of a polynucleotide encoding the chimeric polypeptide to achieve antibody protection, classified in class 800, subclass 3;

Group 9 (claims 38 and 44) drawn to a method of administering an effective amount of a chimeric polypeptide to achieve a CTL response, classified in class 800, subclass 3;

Group 10 (claims 38 and 44) drawn to a method of administering an effective amount of a polynucleotide encoding the chimeric polypeptide to achieve a CTL response, classified in class 800, subclass 3;

Group 11 (claims 46-65) drawn to a method of identifying an agent that inhibits an interaction between the virus and a co-receptor of the virus and a receptor, classified in class 436, subclass 501; and

Group 12 (claims 66-72) drawn to a method of identifying an agent that inhibits viral infection of a cell, classified in class 435, subclass 7.1;

Applicants hereby affirm the prior provisional election of Group I including claims 1-17 and 24 made on March 12, 2002.

Correspondingly, applicants cancel claims 18-23, 25-33, 35-48, 58-59 and 66-72 and acknowledge the withdrawal of non-elected of claims 34, 46, 49-57 and 60-65 from consideration, with the intent to rejoin claims 34, 46, 49-57 and 60-65 at a later time, or alternatively, with reservation of the right to file divisional application(s) directed to the subject matter of those claims if rejoinder is not effected.

Specifically, applicants intend to rejoin the withdrawn method claims 34, 46, 49-57 and 60-65 when the elected product claims 1-17 and 24 (as herein amended, and as may subsequently be further amended) are determined to be allowable. Such rejoinder would be fully proper under these circumstances, for the following reasons:

When an application as originally filed discloses a product and the process for making and/or using such product, and only the claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product for examination through rejoinder procedure in accordance with MPEP §821.04, provided that the process claims depend from or include all the limitations of the allowed product claims.

In the present application the elected claims 1-17 and 24 are directed to a product (chimeric polypeptide) and the non-elected withdrawn claims 34, 46, 49-57 and 60-65 are directed to methods for using the product recited in claims 1-17 and 24. The withdrawn non-elected method claims 34, 46, 49-57 and 60-65 as amended herein recite **all the limitations included in the elected product claims** 1-17 and 24. Consistent with the provisions of the MPEP §821.04, if

product claims 1-17 and 24 are subsequently found allowable, the withdrawn method claims 34, 46, 49-57 and 60-65 may be rejoined for examination.

Applicants, therefore, request the Office to take up the non-elected method claims 34 and 46-65 for examination when product claims 1-17 and 24 are found allowable. Consistent with such intent to rejoin, applicants have amended method claims 34 and 46, notwithstanding the Office's withdrawal of such claims, to present them in form suitable for future examination upon their rejoinder with the allowed elected claims.

Rejections of Claims and Traversal Thereof

In the April 23, 2002 Office Action,

claims 1-17 and 24 were rejected under 35 U.S.C. §112, second paragraph;

claims 1 and 17 were rejected under 35 U.S.C. §112, first paragraph;

claims 1 and 24 were rejected under 35 U.S.C. §102(b) as anticipated by Chackerian, et al. (Proceedings of the National Academy of Sciences, March 1999);

claims 1-8, 10-11 and 24 were rejected under §102(b) as anticipated by U.S. Patent No. 5,518,723 (DeVico, et al.) or U.S. Patent No. 5,843,454 (DeVico, et al.); and

claims 1-8, 10-11 and 24 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 3 of U.S. Patent No. 5,518,723 (DeVico, et al.) and claim 1 of U.S. Patent No. 5,843,454 (DeVico, et al.).

The foregoing rejections of the claims 1-17 and 24 are hereby traversed, in application to the claims as amended herein, and reconsideration of the patentability of amended claims 1-17 and 24 is requested, in light of the ensuing remarks.